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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,796	01/16/2002	Yulun Wang	155695-0238	1554

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EXAMINER

FLANAGAN, BEVERLY MEINDL

ART UNIT PAPER NUMBER

3739

DATE MAILED: 02/03/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/051,796

Applicant(s)

WANG ET AL.

Examiner

Beverly M. Flanagan

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 6/9/03, 8/4/03 and 11/24/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

BEVERLY M. FLANAGAN  
PRIMARY EXAMINER

## **DETAILED ACTION**

### ***Power of Attorney/ Correspondence Address of Record***

It is noted that Amendment C has been signed by an attorney not currently of record in the instant application. Although prosecution of this application has proceeded pursuant to MPEP 714.01(c), a properly executed power of attorney and/or revocation of the previously executed power of attorney should be submitted. Applicant should also note that pursuant to MPEP 403 and 37 CFR 1.33(a), the correspondence address of record remains as set forth in the papers originally filed until properly changed by applicant or his or her duly assigned representative.

### ***Election/Restrictions***

The restriction requirement set forth in the previous Office action (Paper No. 8) is hereby **withdrawn** as unnecessary. Applicant's election of the invention of Species A in Paper No. 9 is noted, but will not be considered by the examiner. Furthermore, accompanying the election of Species A was a listing of claims considered by the Applicant to be pending in the application. This list does not correlate with the amendments to the claims presented in earlier filed amendments A (filed 6/9/03) and B (filed 8/4/03). Specifically, this list considers claims 24-34 to be currently pending whereas amendment A cancels claims 24-34. As amendments A and B were entered and made of record, the status of the claims is as follows: Claims 1-23 and 35 are pending; Claims 24-34 are cancelled.

***Previous Rejections Under 35 U.S.C. § 112***

The previously set forth rejections of claims 6, 10, 20 and 21 have been overcome by amendments to those claims.

***NEW Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35 depends from cancelled claim 34. Since applicant has cancelled claim 34, the examiner has assumed that applicant intended to also cancel claim 35, and its pending status is merely an oversight. Accordingly, claim 35 will not be further treated on the merits.

***Claim Rejections – 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-8, 11-18 and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Tajima et al. (U.S. Patent No. 5,855,553).

Tajima shows a medical robotic system comprising: a first medical device; a first input device (grip 3007 of first operator) that can be moved a first input distance to move said first medical device (102); a second input device (grip 3007 of second operator) that can be moved a second input distance to move said first medical device (102); and a feedback device that provides an indication of a difference between the first and the second input distances by force feedback (Fig. 39); and visual feedback (107), wherein the force feedback is applied to said first and second input devices, said first and second input devices include handles (Figs. 38a, 38b, 38c), a communication interface (103) couples said first and second input devices to said first medical device (102) and said first medical device includes a robotic arm (Fig. 14) coupled to a medical instrument (1401).

### ***Claim Rejections – 35 USC § 103***

The following is a quotation of 35 USC 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tajima et al. (U.S. Patent No. 5,855,553).

Tajima et al. show all of the limitations of claims 9 and 19 except for a switch that allows the first input device to assume sole control of said first medical device.

However, Tajima does disclose a simulation training function that allows the device to

be operated by one person (col. 24). Thus although there is no specific switch disclosed, Tajima does provide for varying the weight of the input of the different surgeons, and it would be obvious to one of ordinary skill in the art at the time the invention was made to provide a switch to simplify such a process.

### ***Response to Arguments***

Applicant's arguments filed with Amendment A have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., feedback from one input device relative to movement of another input device, as described at pages 34-36 of the specification) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Accordingly, as broadly as claimed, the Tajima et al. reference meets the claimed limitations.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

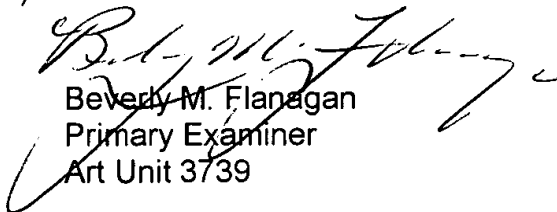
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beverly M. Flanagan whose telephone number is (703) 305-7202. The examiner can normally be reached on Mondays, Tuesdays and Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Beverly M. Flanagan  
Primary Examiner  
Art Unit 3739